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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 37 – 45 and 56 -63 are pending in the application and have been rejected.
No amendments have been made.

CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected the claims 37 - 45 and 56 – 62 under 35 U.S.C. § 103(a), as being unpatentable over Prokoph (US Patent Publication 2002/0091671) in view of Cole (US Patent 6,571,239) and Kim (US Patent Publication 2003/0208482), and rejected claim 63 under 35 U.S.C. § 103(a), as being unpatentable over Prokoph by Cole by Kim in view of Mattal (US Patent Publication 2004/0261021). Applicant respectfully traverses these rejections in view of the remarks that follow.

Prokoph is not relevant to the herein claimed invention. This is because he does not deal with web indexes. In fact, he is very specific that he is not dealing with them (see Paragraph 6) and teaches away from the instant Invention. "...a typical search pattern will result in an unwieldy number of search hits, making it difficult to analyze the results. ...". Accordingly, it is very clear that not only does Prokoph not search web indexes, but it is also clear that, while he knew about them, he does not want to deal with them. Thus, not only does Prokoph not discuss "adding information from at least some of said user queries to said enhanced web index," but he also fails to teach or disclose "searching an enhanced web

index.” He does not address web indexes, so he obviously does not teach searching them or updating them.

As related in Paragraph 9, Prokoph explains why searching web indexes is inadequate in his opinion. So he again is clarifying that while he knows about them, he is not dealing with web indexes.

”... The relevance of the retrieved documents is generally poor... Therefore, users typically need to issue more than one search request to find the information they are seeking. ... the highly relevant documents within a search result list are embedded in an often very large number of non-relevant documents ...”

Moreover, this failure to utilize web indexes cannot be resolved by reference to Kim. While the Examiner states that Kim discloses an indexer that extracts anchor text, he makes no attempt to explain why such an index could or would be used in Prokoph. To the contrary, such an index could not and would not be used by Prokoph because he specifically says he would not use such an index because it creates too big a file and is not useable.

Furthermore, Prokoph specifically references the existence of web indexes, and he says not to use them. Thus, Kim is irrelevant. Web indexes were not created by applicant or Kim or Prokoph. Prokoph knew about them and says to not use them. Hence Kim adds nothing to the discussion. He discloses what Prokoph already knew and rejected.

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (M.P.E.P. 2143.01) Therefore, the teaching of Kim cannot be utilized in Prokoph as it would make Prokoph unsatisfactory for its intended purpose. His purpose is to avoid a perceived problem of web indexes in that they accumulate too much data. He therefore stores and accesses data differently and without web indexes. By utilizing web indexes his entire purpose is frustrated,

Moreover, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (M.P.E.P. 2143.01) By incorporating Kim or web indexes into Prokoph, one necessarily has to change Prokoph’s

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principle of operation. When an inventor says he is not using a certain element because of certain stated problems, it most certainly is not obvious to introduce that very element into his system. Prokoph created a system which operates without web indexes and is intended to not use them. To utilize web indexes requires a re-formation of Prokoph to something he did not want to do.

“Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. ... Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking.” (M.P.E.P. 2145)

It seems that the Examiner is using such hindsight reasoning.

Stated succinctly, without providing any basis, the Examiner says Kim's index can be utilized in Prokoph, but this is contrary to Prokoph's express teaching to not use web indexes. The PTO has affirmatively determined, however, that “It is improper to combine references where the references teach away from their combination.” M.P.E.P. 2145.

Prokoph knew about web indexes and specifically discusses them in his patent. His conclusion is that they should not be used. Therefore, it is inappropriate (and actually wrong) to say that a person skilled in the art would incorporate web indexes into Prokoph. Why would someone incorporate a web index into Prokoph if he says not to use them? Why incorporate a web index into Prokoph if it requires a change in his principle of operation?

“Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.” (M.P.E.P. 2143.01) Not only is there no teaching, suggestion or motivation to combine the teaching, but the reference expressly states that the combination should not be made.

Claim 37 recites "searching an enhanced web index" and "adding information from at least some of said user queries to said enhanced web index", with similar language in claim 56.

Since the Prokoph does not deal with web indexes and even suggests that they should not be used, this reference does not anticipate or obviate the herein claimed Invention. Kim's index cannot be utilized therein as it is not compatible with Prokoph and in any event Prokoph says not to use them in his process.

Cole does not deal with adding information to such a web index. Instead, Cole "provides methods ... which solve the problem of mismatch between the keywords employed by a user in making a query and those assigned by the ... classification system stored in the system's keyword index. ... If in a query session the user is satisfied with the object(s) retrieved from the repository, the system associates the initial keywords(s) with the retrieved object(s). ... The keyword index is modified directly ..." (Column 1, lines 6 - 10).

In particular, Cole is working with a "keyword index" as opposed to a "web index." These are two entirely different types of indices with very different purposes.

It is clear that by the "Repository 115" (Column 3, lines 1 - 39), Cole is referring to what Applicants call the document index. Instead of adding the query words to it, Cole is adding the query words to his keyword list in his search engine. Accordingly, it is clear that Cole does not teach or suggest "adding information from at least some of said user queries to said enhanced web index." Cole adds nothing to the document index (what he calls a Repository), and certainly not to a web index.

Moreover, in describing how the system operates, Cole nowhere mentions that a web index is updated or modified based on the queries.

Cole teaches that either the Master Index or the Auxiliary Index is updated (Column 4, line 54, - Column 5, line 2), but nowhere teaches or suggests that the document index should be updated.

Cole recognizes that they are not updating a web index (Column 2, lines 40 -67). The summary of their invention states that it is

"a method... to modify the associations between objects in the database and keywords in the index, based on keywords supplied by the user during a search session." (Column 2, lines 5 -10)

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The master index is the main keyword index which can be modified by only authorized users. When the system is not used by authorized users, then an Auxiliary Keyword Index is created and modified. In either case, however, the index of information itself is not being changed. On the keyword index is being changed.

In summary, Prokoph does not disclose or suggest searching a web index and does not mention updating any document index, let alone a web index, based on words used in a query. Moreover, and most importantly, he specifically says to not use web indexes, so there is no basis to incorporate Kim's index into Prokoph. Cole also makes no mention of web indexes and discusses only updating the keyword indexes. There is no teaching or suggestion of updating any document index, let alone a web index, based on words used in a query. Only a keyword index is updated, but not any document index.

The Examiner concedes that a combination of Prokoph and Cole does not obviate the invention. Adding the disclosure of Kim does not thereby obviate the herein claimed invention, because Prokoph knew about web indexes and said to not use them. Kim adds nothing that Prokoph did not already know and disclose and reject. Accordingly, the herein claimed invention is not obvious.

Accordingly, Applicant asserts that Prokoph in combination with Cole and Kim neither teaches nor suggests the limitations of claims 37 or 56. Accordingly, Applicant respectfully asserts that independent claims 37 and 56 are allowable. Claims 38 – 45 and 57-63 depend from, directly or indirectly, claims 37 and 56 and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 38 – 45 and 57 – 63 are likewise allowable.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejections and allow all the claims

In view of the foregoing amendments and remarks, the ending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

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Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this response to Deposit Account 09-0468.

Respectfully submitted,

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